

REMARKS

Claims 1- 16 are pending. The Office requested an election under 35 U.S.C. § 121 between the following groups: Group I – Embodiment I of Figure 1; Group II – Embodiment II of Figure 2. Applicant affirms the election of Embodiment I – Figure 1, claims 1, 3 – 9, and 11 – 16 without traverse. Accordingly, Claims 2 and 10 have been withdrawn from consideration in view of the Office's restriction requirement.

The Office objected to drawing Figures 1, 3 – 5 under 37 C.F.R. 1.83(a), asserting that these figures must show every feature of the invention specified in the claims. Applicant respectfully traverses this objection. Paragraph [0019] of the application describes in detail the various alternative embodiments for the restraint corresponding to claims 4-6, and 11-13. Thus, it is submitted that Paragraph [0019] in combination with existing drawing Figures 1-5 is more than sufficient to satisfy the enablement and written description requirements of § 112 ¶ 1 and 2 without requiring modifications to the drawings to show these various alternative embodiments for the restraint. Furthermore, in the alternative, Section 608.02(f) of the Manual of Patent Examining Procedure specifically states that the requirement that the drawing figures must show every feature of the invention specified in the claims "does not apply to a mere reference to minor variations nor to well-known and conventional parts." MPEP § 608.02(f). As such, Applicant submits that alternate embodiments described in Paragraph [0019] of the application corresponding to claims 4-6 and 11-13 are mere minor various and well-known or conventional parts. Accordingly, Applicant respectfully requests that the Office's objection be withdrawn, and the drawings accepted as previously submitted.

The Office rejected claims 7 and 15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Office asserts that the recitation of "said open top end is larger in size than said open bottom end" is unclear as to which particular structural feature of the open top end is larger in size than a particular feature of said open bottom end. It is respectfully submitted that the specification clearly teaches that "[t]he open top end 32 is preferably larger in size than the open bottom end" (See page 5, lines 9 – 10, and Figure 1 of the instant application). This description includes within its scope the preferred

frustro-conical embodiment as shown in the drawing figures, or any other embodiment (including cylindrical, rectangular, etc.) wherein the top of the boot is larger in size than the bottom of the boot such that the inverted oil filter canister can be grasped and removed from the boot through the open top end. While applicant submits that the original claim, in view of the written description and drawing figures, is not indefinite, in order to overcome the Office's rejection, Applicant, has amended claims 7 and 15 to make it more clear that "at least a portion" of the open top end of the boot is "substantially greater in diameter" than the open bottom end of the boot. Accordingly, Applicant respectfully requests withdrawal of the rejection in view of the amendment to claims 7 and 15.

The Office rejected claims 1, 5-9, and 11-16 under 35 U.S.C. 102(b) as being anticipated by Krauss (U.S. Pat. No. 4,376,703). The Office states that Krauss "discloses in figure 5, a oil containment apparatus mounted on an engine comprising a circular first end; a circular second end; a peripheral wall connecting said first end and said second end; a restraint proximate said first end having an elastomeric band; wherein a diameter of said second end is greater than a diameter of said first end."

Applicant respectfully traverses this rejection. The Krauss '703 reference (as well as each of the other relevant references of record), discloses a device for use with oil filter canisters disposed in the conventional manner on the bottom or sides of an engine block. Thus, neither the Krauss '703 reference nor any of the other references of record disclose an oil containment boot for use with an inverted oil filter canister. Accordingly, in order to make this distinction more clear, Claim 1 has been amended to positively recite the oil containment boot in combination with an inverted oil filter canister disposed on an oil filter receiving base. Furthermore, Krauss '703 fails to disclose an oil containment boot having a restraint proximate said open bottom end for sealingly securing said open bottom end of the oil containment boot operably over the oil filter receiving base, as originally claimed. Rather, Krauss '703 discloses that the open bottom end of the cover is sealed around oil filter canister and that the top end of the cover is sealed against the engine block. Specifically, Krauss teaches an oil containment apparatus having at "the other or lower end of the cup-shaped cover . . . a seal structure 34 is provided including at least two bendable flanges 35 that engage tightly against a contacting surface of the oil filter 12."

Krauss further teaches in another embodiment "[s]imilar seal arrangements 34, 35, and 36 are provided for engaging between the cover 60 and the oil filter 12." (See, col. 3, line 16 – col. 4 line 23.) Thus, the Krauss '703 reference (like the other relevant references of record) are completely opposite of the orientation of the oil containment boot and oil filter canister of the present invention. To anticipate a claim, every limitation of the claim must be disclosed by a single prior art reference either explicitly or inherently. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327 (Fed. Cir. 2001). Accordingly, since the Krauss '703 patent fails to disclose each of the limitations of Claim 1 as amended, the Office's 102(b) rejection of Claims 1 and 5-8, should be withdrawn.

Likewise, amended Claim 9 specifically claims "(a) providing a used inverted oil filter canister disposed on an oil filter receiving base . . . (c) placing said open bottom end of said oil containment boot over said used inverted oil filter canister; (d) sealingly securing said open bottom end of said boot operably over said oil filter receiving base such that said peripheral side wall of said boot extends a distance above said oil filter receiving base and surrounds at least a portion of said used inverted oil filter canister disposed therein; (e) threadably removing said used inverted oil filter canister from said oil filter receiving base through said open top end of said boot" Thus, as identified above, not only does Krauss '703 fail to disclose an inverted oil filter canister, but the method disclosed and taught by Krauss '703 is completely opposite the claimed method of claim 9. Accordingly, since the Krauss '703 patent fails to disclose each of the limitations of Claim 9 as amended, withdraw of the Office's 102(b) rejection of Claims 9 and 13-16 should be withdrawn. *Telemac*, 247 F.3d at 1327.

With respect to claims 8 and 16, the Office asserts that the peripheral wall of Krauss is inherently movable between a first containment position and a second folded position. Applicant traverses the Office's assertion that Krauss inherently discloses that the peripheral wall is movable between a first containment position and a second folded positions. However, the need to address the merits of the Office's inherency assertion is unnecessary in view of the fact that Kraus fails to disclose an oil containment boot in combination with an inverted oil filter canister (as required by claim 8) or providing a used inverted oil filter canister (as required by claims 16).

As such, the Office cannot, as a matter of law, maintain its 102 rejection of claims 8 and 16.
Telemac, 247 F.3d at 1327.

The Office rejected claims 3, 4, 11, and 12 under 35 U.S.C. 103(a) as being unpatentable over Kraus in view of Wells. Specifically, the Office asserts that "Krauss discloses the basic apparatus as previously cited . . ." Applicant submits that this assertion in view of the amended claims is not accurate.

As previously identified, as to claims 3 and 4, which depend from claim 1, Kraus fails to teach or discloses an oil containment boot in combination with an inverted oil filter canister to prevent oil spillage upon removal of the inverted oil filter canister. In addition, Claims 1 specifically requires "a restraint proximate said open bottom end for sealingly securing said open bottom end of the oil containment boot operably over the oil filter receiving base." Claims 3 further defines the restraint to include a clamp. Claim 4 further defines the restrain to include adhesive. Thus, upon removal of the inverted canister, the oil escaping from the removed inverted oil filter canister is captured and retained within the boot so it can drain downwardly back into the engine block. Krauss, on the other hand, teaches sealing the top of the oil containment cover to the engine block and that the bottom of the oil containment cover is sealed around the filter. Similarly, Wells teaches securing the top of the body 12 to the engine block and fails to disclose sealing the bottom of the body 12 any structure. Thus, the teachings of Krauss and Wells are completely opposite of the inventions of claims 1, 3 and 4, in that both Krauss and Wells teach a device for capturing and retaining the oil draining downwardly out of the engine block upon removal of the oil filter canister, not to create a reservoir to capture the oil escaping from the oil filter canister upon its removal for draining back into the engine block. Teaching away from the claimed invention is a per se demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988).

Likewise, with respect to claims 11 and 12, which depend from claim 9, Krauss does not teach or disclose providing a used inverted oil filter canister. In addition, Claim 9 specifically requires "sealingly securing said open bottom end of said boot operably over said oil filter receiving base." Claim 11 requires clamping said open bottom end of said boot operably over said oil filter receiving base. Claim 12 requires adhering said open bottom end of said boot

operably over said oil filter receiving base. Thus, upon removal of the inverted canister, the oil escaping from the removed inverted oil filter canister is captured or retained within the boot until it can drain back into the engine block. As previously identified, this is completely opposite the orientation of the cover 16 of Krauss and body 12 of Wells which are used to capture the oil draining out of the engine block upon removal of the oil filter canister, not to create a reservoir to capture the oil escaping from the oil filter canister upon its removal for draining back into the engine block. Teaching away from the claimed invention is a per se demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988).

Based on the foregoing, it is respectfully submitted that the Office's objections and rejections of the pending claims have been overcome and that the claims 1, 3-9 and 11-16, as amended, are in condition for allowance. Accordingly, Applicant's respectfully request that claims 1, 3-9 and 11-16, as amended, be allowed.

Respectfully submitted,

Ronald C. Carlson



Thomas J. Oppold
Registration No. 42,054

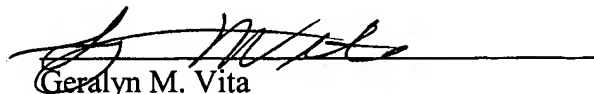


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Pursuant to 37 CFR 1.10, I hereby certify that this Amendment in U.S. Application Serial No. 10/065,182, is being deposited with the U.S. Postal Service by Express Mail, Post Office to Addressee service, addressed to: Mail Stop Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date of deposit and under the mailing label number indicated below.

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GERALYN M. VITA

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